

REMARKS

The Requirement for restriction was directed to claims 1-18, which have been cancelled herein. New claims 19-36 are presented herein for the Examiner's consideration. Entry of these claims is respectfully requested. Upon entry of these amendments, new claims 19-36 are pending in the present application.

Support for the new claims can be found in the original claims and throughout the specification. Specifically, support for new claim 19 is found in original claims 1, 2, and 4 and in Example 4, at page 21, line 20 over to page 22, line 4; Table 3; and page 10, lines 14-17. Support for new claims 20-23 is found in original claims 3, 5, 6, and 13, respectively. Support for new claim 24 is presented in original claim 13 and at page 12, lines 14-20 and in Example 4, at page 21, line 20 over to page 22, line 4 and Table 3. Support for new claim 25 is found in original claim 7 and at page 12, lines 21-22; at page 6, lines 19-23; and at page 10, lines 14-17. Support for new claim 26 is presented in original claim 8 and at page 12, lines 21-22; at page 6, lines 19-22; and at page 10, lines 14-17. Support for new claims 27-36 is found in original claims 9-18, respectively. No issue of new matter is introduced by these claims.

By this Office Action, the Examiner has required restriction to one of the following inventions under 35 U.S.C. §121:

Group I. Claims 1-6, 16, and 18 to a method of transforming trees to modify the fibre characteristics in trees comprising transforming said plant with any gene that modifies the extension of fibre cell walls, classified in class 800, subclass 290 for example.

For the election of Group I, an election of sequence has been required for one of the following and to specify if the sequence is *Eucalyptus* or cucumber:

SEQ ID NO:1; SEQ ID NO:2; SEQ ID NO:3;

SEQ ID NO:4; SEQ ID NO:5; SEQ ID NO:6.

Group II. Claims 7-15 and 17, drawn to a chimaeric gene comprising a nucleic acid operably linked to a promoter in sense orientation and terminator, and transformed tree, classified in class 800, subclass 290 for example.

Group III. Claims 7-15 and 17, drawn to a chimaeric gene comprising a nucleic acid operably linked to a promoter in antisense orientation and terminator, and transformed tree, classified in class 800, subclass 290 for example.

For the election of Group II or Group III, an election of sequence has been required for one of the following:

SEQ ID NO:1; SEQ ID NO:2; SEQ ID NO:3;
SEQ ID NO:4; SEQ ID NO:5; SEQ ID NO:6.

Applicants have cancelled claims 1-18 upon which the Requirement for restriction was based, thereby obviating the requirement as it pertains to the cancelled claims. New claims 19-36 are presented herein. Should the Examiner apply a similar Requirement for restriction to newly presented claims 19-36, applicants elect to prosecute the invention of Group I, as this applies to these claims, with traverse. Applicants submit that the claims of Group I comprise at minimum, Claims 19-23, 31 and 34-36.

Original claims 7-15 and 17 which were placed in Group II, and which have been replaced with claims 25-30, 32, 33 and 35, are purportedly all drawn to or based on a chimaeric gene that in turn, is asserted to comprise a nucleic acid operably linked to a promoter in sense orientation and terminator. Applicants understand that the claims as characterized in Group II are fundamentally related to the corresponding claims of Group III, which appear to differ in the Examiner's characterization, only by the orientation (or 'arrangement') of the nucleic acid

sequence. Applicants accordingly urge that the reversal in orientation does not change the identity of the sequences, and that such variations are well known in the art and are capable of facile analysis and search. The search for any of the compositions separately classified by the Examiner as the invention of Group II would require an additional search of the identical classes wherein the claims of Group III are classified, thus resulting in a duplicate search for the same material.

Moreover, original Claim 17 (corresponding to new Claim 35) is directed to a tree transformed using a method of the invention, and should be grouped with the method claims of Group I, so that at minimum, inclusion of claim 35 with the method claims placed in Group I is in order.

Inasmuch as newly presented Claims 19-23, 31 and 34-36 are drawn to methods which utilize the chimaeric genes and nucleic acid sequences of the claims of Groups II and III, as such designation may apply to newly presented claims 25-30, 32 and 33, applicants assert that a search for any of the methods or compositions used in these methods would involve duplicate searches of the same material. Thus, applicants submit that in view of the newly presented claims, the Search and Examination of the entire Application (Groups I-III, as they may apply to new Claims 19-36), or, at least, of Group I with Group II can be made without serious burden, and therefore applicants respectfully request that the Examiner enter the amendments as set forth herein and examine all of the claims of the Application on the merits.

The Examiner's assertions to the contrary notwithstanding, applicants respectfully submit that conjoint examination and inclusion of all of the Claims of the present Application would not present an undue burden on the Examiner, and accordingly, withdrawal of the Requirement for Restriction, or, at the least, modification to include the Claims drawn to Group I (wherein new Claim 34 is rejoined to Group I) and Group II is in order.

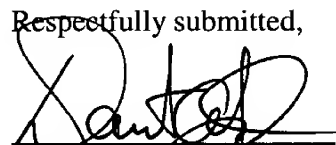
No additional fees are believed to be necessitated by the foregoing Response. However, should this be erroneous, authorization is hereby given to charge Deposit Account No. 11-1153 for any underpayment, or credit any overages.

Application No.
09/383,579

PATENT
2531-1-001

In view of the above, entry of the amendments and withdrawal of the Requirement for the Restriction is requested, and an early action on the merits of the Claims is courteously solicited.

Respectfully submitted,



DAVID A. JACKSON
Attorney for Applicant(s)
Registration No. 26,742

KLAUBER & JACKSON
411 Hackensack Avenue
Hackensack, New Jersey 07601
(201) 487-5800

Date: June 26, 2003